IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Y. V. S. N MURTHY et al.

Application No.: 10/623,114 Art Unit: 1617

Filed: July 18, 2003 Examiner: J. Kim

For: COMPOSITION CONTAINING PRODRUGS OF FLORFENICOL AND METHODS OF USE

Attorney Docket No.: 13390 / 07011

RESPONSE TO RESTRICTION REQUIREMENT

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In the Restriction Requirement, mailed August 10, 2006, the Examiner has required that an election be made to one of the following allegedly distinct inventions:

> **Group I.** Claims 1-10 and 16-17, drawn to a composition of a prodrug of florfenicol and a pharmaceutically acceptable carrier, provided in an injectable composition and a compound of florfenicol, classified in class 514, subclass 618; class 465, subclass 212.
>
> **Group II.** Claims 11-15 and 18-24, drawn to a method of administering florfenicol to a mammal comprising administering a composition containing a prodrug of florfenicol to the mammal, wherein the prodrug is converted *in vivo* by endogenous enzymes into florfenicol, classified in class 514, subclass 618.

Applicants respectfully elect the claims of Group I (*i.e.*, claims 1-10 and 16-17) with traverse for prosecution in this application.

Applicants respectfully request that the restriction requirement between Groups I and II, be withdrawn and that Group II be examined together with the claims of elected Group I. This would require no additional searching by the Examiner and would not impose an undue burden because the inventions of Groups I and II represent closely related subject matter. Indeed, a

search directed to the claims of Group I would also identify prior art that encompasses the additional claims in Group II because, as indicated in the Restriction Requirement, class 514 subclass 618 will be searched for the claims of Group I and class 514 subclass 618 is the class that encompasses the claims of Group II.

Moreover, the Examiner states in the Restriction Requirement that restriction is proper because:

> Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. [ ] In the instant case *the process as claimed can be used in a materially different process of using the product since the product can be used to treat bacterial infection.*

(emphasis added). Applicants respectfully submit that the Examiner's basis for restriction, *i.e.*, "the process as claimed can be used in a materially different process of using the product since the product can be used to treat bacterial infection," is improper because the claimed process of administering a prodrug of florfenicol is used to treat bacterial infections (*See*, Specification, [0003] - [0004]). Thus, using the product to treat a bacterial infection is not "a materially different process of using the product," as alleged by the Examiner. Accordingly, it is respectfully requested that the Examiner withdraw the restriction of the currently pending claims into Group I and Group II. The Examiner is expressly requested to address this request in the next Office Action.

It is respectfully submitted that all claims are in condition for allowance, early notice of which would be appreciated. Should the Examiner disagree, Applicants respectfully request a telephonic or in-person interview with the undersigned attorney to discuss any remaining issues and to expedite eventual allowance of the claims.

No fee is believed to be due for this submission. Should any fees be required, however, please charge the required fees to Kenyon & Kenyon deposit account no. 11-0600.

Respectfully submitted,

Date: August 25, 2006

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